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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,378	02/10/2005	Timothy J. Philpot	GB02 0130 US	4848
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EXAMINER SILBERMANN, JOANNE				
ART UNIT 3611		PAPER NUMBER		
MAIL DATE 08/04/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,378

Applicant(s)

PHILPOT, TIMOTHY J.

Examiner

Joanne Silbermann

Art Unit

3611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 15-24 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15-21, 23, 26-35 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15, 23, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "standard" in claims 15, 33 and 34 is considered to be indefinite since this does not adequately describe any particular size or shape.

In claim 23 line 5 "the card" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18-20, 23, and 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Shultz, US patent #5,848,687.
5. Shultz discloses an apparatus comprising a holder for at least one computer storage medium (Figure 4) the holder having a substantially planar shape having first and second substantially planar faces (top and bottom, Figure 4) separated at least by one outer edge, the planar shape defining at least one opening that extends through the planar shape from the first to the second planar face (Figure 3), the opening having

means including at least one inner edge (Figure 5) for at least partially surrounding the medium in such a manner that when the medium is in the opening the medium does not protrude beyond either the first or second planar faces (Figure 2).

6. The holder includes flexible material (column 3 line 1) which provides a means for deformable accommodation (entry and removal) for a storage medium. The opening is approximately the same size as the storage medium.

7. The holder includes a protrusion comprising a pair of lips (Figure 5) for placement at two opposing sides of the storage medium.

8. The holder is suitable for accommodating a storage medium having two substantially planar faces and as edge separating the faces, the opening being such that when the storage medium is present (Figure 2) neither planar face of the medium is entirely covered and the planar faces of the medium are parallel to and do not protrude from the card (as best as can be understood).

9. Regarding claim 31, the planar shape has a size suitable for insertion into a wallet.

10. Regarding claim 32, the holder comprises a bendable region (the entire holder is bendable) for flexing the planar shape to allow insertion and removal of the medium.

11. Regarding claims 33 and 34, the holder is considered to have the size and shape of a credit card and business card.

12. Regarding claim 35, the holder is bent along an axis when it is deformed for insertion or removal.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shultz.

15. Shultz does not specifically teach the size and thickness of the holder. However, it would have been obvious to one of ordinary skill to make the thickness of the holder less than 5mm since the holder is intended to be thin but yet provide adequate coverage for the disk. It also would have been obvious to one of ordinary skill to make the holder rectangular (or any other well known shape) and of a convenient size depending on the intended use of the holder (such as, to place in a wallet).

16. Claims 15-17 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego, EP 1,083,563 A1 in view of Walker, US patent #5,533,614.

17. Regarding claims 15, 26 and 27, Perego teaches holder 2 to which a computer readable storage medium can be detachably attached. The holder has a planar shape (Figure 1) and a size corresponding to a conventional credit card (column 2 lines 44-46). Based on the size of the storage medium shown (in Figures 4 and 5 for example) the length of the holder is at least 100% greater than the width of the storage medium.

18. Perego does not teach more than one means for detachably attaching a storage medium however a holder for more than one such medium is well known in the art as shown by Walker. Walker teaches a holder for computer readable storage media

wherein more than one medium may be detachably attached thereto. It would have been obvious to a person having ordinary skill in the art to provide two such attaching means (as taught by Walker) on the holder of Perego so that multiple media may be detachably retained on a single holder.

19. Regarding claim 16, Walker shows the media held side by side.
20. Regarding claim 17, the holder is adapted to hold small form factor optical disks.
21. Regarding claims 28 and 29, the storage medium is not part of the claimed invention, therefore the size of the holder is considered to be at least 100% greater than the width of the computer readable storage medium if a small medium is used.
22. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shultz in view of Helmer et al. US patent #2,910,793.
23. Shultz does not teach one lip as being longer than the other however this is well known in the art of holders as shown by Helmer. Helmer teaches a holder wherein one lip is longer than the other. It would have been obvious to one of ordinary skill in the art to utilize such different sized lips in the holder of Shultz so that the item held therein is more securely retained.

Allowable Subject Matter

24. Claim 24 is allowed.
25. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Regarding the objection to the word "standard", the examiner maintains the previous rejection. Applicant admits that the use of such a word would change the meaning of the claim over time.

Rejection under Perego

26. Applicant's arguments, see response, filed 5/11/09, with respect to the rejection(s) of claim(s) 15 under Perego have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Walker.

27. Rejection under Helmer

28. Applicant argues that there is no prohibition on patenting an old device for a new use however Applicant's claims are not directed toward any new use (or method) but to the article itself.

29. Rejection under Walker

30. Applicant argues that Walker cannot be combined with Perego Walker was patented at a time when disks were much larger, however Walker states that the holder is for optically read discs (column 1 line 10). No particular size is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joanne Silberman
Primary Examiner
Art Unit 3611

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